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EXAMINER

AMSBURY, WAYNE P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2171

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/819,063

Applicant(s)

HALL ET AL.

Examiner

Wayne Amsbury

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 29-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 29-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/27/99 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS 1 AND 29-96 ARE PENDING

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. An initial IDS statement was misplaced because it was supplied with an incorrect (parent) application number and filing date. A supplementary IDS statement (2 pages, 28 November 2001) is numbered as paper #4; the initial IDS (29 pages, 8 December 2000) is numbered as paper #9. Both have been considered.

A pre-amendment A cancelled claims 2-28; a pre-amendment B added claims 29-96.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Johnson et al (Johnson), US 5,991,876, 23 November 1999.

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4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 29-66 and 82-96 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims are conceptual abstractions that do not fall within the guidelines for statutory matter. The guidelines allow for a data structure on a computer-readable medium and for a computer program product, meaning executing instructions embodied on a computer-readable medium.

These claims are based in part on the use of: "*descriptive* data structure", [emphasis added]. Taken at its face value, (explicitly noted to be *abstract* in claim 1), this basic element of the invention is an abstraction, a concept, and it is clearly not statutory.

For instance, claim 37 sets forth a *descriptive* data structure that describes a "secure container ... accessed in an *electronic appliance* ... OR containing software." The alternative form reduces this to a description of a secure container that is accessed in an electronic appliance.

Not only is claim 37 non-statutory in form as a mere description and abstraction, but the term *electronic appliance* is clearly intended to be a broad term that may include a refrigerator as well as the potential embodiment of a computer.

The other claims cited exhibit similar and related problems.

In the interest of compact prosecution, prior art is applied as though the claims were placed in statutory form with elements that are as similar as possible.

In particular, it is assumed that the intent is a data structure embodied on a computer-readable medium and used during the execution of a program.

The intent of the examined claims is conjecture on the part of the Examiner and it is incumbent on the Applicant to rectify the distinctions made in this interest.

5. Claims 1 and 29-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are based in part on the use of: "*descriptive* data structure", [emphasis added]. Any formal data structure, as opposed to structured data in and of itself, is an organizational scheme; it is a formal description of the potential structure of one or more data sets. Any data structuring caused by computer software inherently requires a description within the software. Thus any computer-generated concrete data structure inherently requires a descriptive data structure of its architecture to be embodied within the software that produces it. The intent of including the term *descriptive* in the claims is not at all clear, as it appears to be redundant.

The phrase: "the representation" in claim 1 fails to have a proper antecedent.

The scope of the term "interoperability" (or "interoperate") in claims 1 and 32-35 is not clear. It may be taken to mean that *each* party accesses or communicates with the other or that *one party* manages the other or accesses or communicates with the other. In the interest of compact prosecution, it is assumed that this means that one party communicates with the other in some fashion.

The term *container* is currently taken to be either of two common meanings in the art [Microsoft Computer Dictionary, 1999]: (a) the OLE term denoting a file containing linked or embedded objects, or (b) in SGML, an element that has content as opposed to one consisting solely of the tag name and attributes. The Specification appears to contain neither of the terms OLE or SGML, both in use at the time of the invention, but it does teach the use of a specific alternate, the DigiBox container model [page 3 lines 3-6], which is in turn defined in terms of the very general term “package”. This embodiment is packaged to the extent that it can be used to “store, transport and provide a rights management interface ...” [page 3 lines 15-19]. Furthermore, the term *container* has been applied as a categorical description of a Web page [COL 2 lines 22-34, Herrman, US 5,995,756, 30 November 1999, applied below].

In the interest of compact prosecution, a “secure container” is thus any one of the above that comprises an element that regulates the security of access to its contents.

Claim 36 includes the phrase: “the degree to which the secure environment can trust the source”. This does not have a proper antecedent, and is of indeterminate scope. In the interest of compact prosecution it is assumed that the intent was: “a measure of the degree ...”

Claims 44-81 and 87 are based in part on the use of the term “govern” in some form. This term has a variety of common meanings. As instances, it is not clear what is meant by “governed information” in claim 44 or to “govern an aspect of access to” in claim 67. All information in a data structure is surely governed in some way, shape, manner or form, but it is not clear which possibility is intended as a limitation.

As to claim 67, it is further not clear whether or not an *aspect* is an attribute or parameter or element, any of which might be regulated or managed or controlled in some fashion, or have its use required. The specific intent of these terms needs to be clarified on the record.

In a Response that specifies the intent of any phrase addressed above, please include the Specification support for that interpretation.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 29-96 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

One of skill in the art would not be able to make or use the invention set forth in the claims for a data structure that is descriptive, as opposed to one that is embodied on a computer-readable medium and used in the execution of a computer program.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 44 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al, (Johnson), US 5,991,876, 23 November 1999.

As to claim 44, the database structure of Johnson comprises a descriptive data structure.

Johnson addresses the schema of the database as a whole as a rights-management data structure [FIG 4; COL 6 line 63 to COL 8 line 43], but the database schema is a hierarchy in which a number of components would serve as well. One level down, the Order table of serves as such a structure, and it identifies a Rights table, which in turn identifies a Works table that in turn identifies a Party table.

Some of the components of these tables are clearly identifiers that determine other tables and records of the structure.

The Rights table itself also serves as a descriptive Rights Management data structure, and it contains governed information, such as **412** Right-Holder.

The term **rule** has a variety of meanings, one of which is: *A standard procedure or method for solving a class of mathematical problems*. The Right_fee field **418** may contain a formula [COL 7 line 51], which encapsulates a procedure of computation. The Right_grant field **420** records a Boolean switch, which determines a rule, (to grant or not to grant).

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 40-43 and 45-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al, (Johnson), US 5,991,876, 23 November 1999.

As to claims 40-43 and 49-66, Johnson applies multiple rules in a more general sense than applied above as means to make decisions, to add, delete, and edit entries, to authorize a use, and to govern displays. See for example, FIG 5-6 and the discussion in COL 9 lines 35-65. The explicit expressions of the limitations set forth in these claims differ from those of Johnson, but are either subsumed by the teachings of Johnson or they are well known techniques of implementation in the art.

The context of the limitations is not clear, as indicated by the 112.1 and 112.2 and 101 rejections above, but within the broadest reasonable interpretation of that context, the limitations of the claims appear to be housekeeping details and/or obvious extensions and/or techniques required to implement the rights management structure of Johnson.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a viable implementation of the descriptive data structure because that adds life and meaning to what is otherwise merely a conceptual structure.

9. Claims 29-39, 45-48 and 67-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al, (Johnson), US 5,991,876, 23 November 1999 as applied above, in view of Herrmann, US 5,995,756, 30 November 1999.

These claims include the limitation of a *secure container*. The rights management structure of Johnson is directed to security by its nature, but Johnson fails to package the rights management structure explicitly as a container. Herrmann teaches the packaging of corporate application components as containers, specifically as Web pages, [COL 2 lines 23-26], but does not specifically address rights management or security.

However, rights management is dynamic and granular [Johnson, ABSTRACT], and clearly within the paradigm of corporate applications [Johnson, FIELD].

Johnson recognizes that various items or works may be combined into different packages [Johnson, COL 2 lines 31-33], and authorization should recognize this and other complex issues [Johnson COL 2 lines 52-54].

It would have been obvious to one of ordinary skill in the art at the time of the invention to package rights management structures as secure containers because secure packages of authorization are corporate data within applications that are increasingly connected by the Internet.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 703-305-3828. The examiner can normally be reached on M-TH 7-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

WPA
March 18, 2003


WAYNE AMSBURY
PRIMARY PATENT EXAMINER